



12-16-03

#9 am  
12-16-03  
AFT

Walker  
&  
Jocke

a legal professional association

Ralph E. Jocke  
Patent  
&  
Trademark Law

December 15, 2003

RECEIVED

DEC 22 2003

GROUP 3600

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
PO.Box 1450  
Alexandria, VA 22313-1450

Re: Application Serial No.: 09/972,400  
Confirmation No.: 5065  
Applicants: Jay Paul Drummond, et al.  
Title: Automated Banking Machine and System  
Docket No.: D-1077+14 DIV

Sir:

Please find enclosed the Supplemental Appeal Brief of Appellants pursuant to 37 C.F.R. § 1.192 in triplicate, in response to the Action dated September 15, 2003, for filing in the above-referenced application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of the Supplemental Appeal Brief and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke  
Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to addressee in an envelope addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 this 15th day of December 2003.

EL966068127US  
Express Mail Label No.

330 • 721 • 0000  
MEDINA

330 • 225 • 1669  
CLEVELAND

330 • 722 • 6446  
FACSIMILE

rej@walkerandjocke.com  
E-MAIL

231 South Broadway, Medina, Ohio U.S.A. 44256-2601



D-1077+14 DIV

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:

**Jay Paul Drummond, et al.**

Serial No.: **09/972,400**

Art Unit 3628

Confirm. No.: **5065**

Patent Examiner

Filed: **October 5, 2001**

Pedro R. Kanof

Title: **Automated Banking Machine  
and System**

Mail Stop Appeal Brief - Patents  
Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

**RECEIVED**  
DEC 22 2003  
**GROUP 3600**

**SUPPLEMENTAL BRIEF OF APPELLANTS  
PURSUANT TO 37 C.F.R. § 1.192**

Sir:

The Appellants hereby request reinstatement of the appeal pursuant to 37 C.F.R. § 1.193(b)(2). The Appellants hereby submit their Supplemental Appeal Brief pursuant to 37 C.F.R. § 1.192, in triplicate, concerning the above-referenced Application.

**REAL PARTY IN INTEREST**

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

## **RELATED APPEALS AND INTERFERENCES**

Appellants believe that there are no related appeals or interferences pertaining to this matter.

## **STATUS OF CLAIMS**

Claims 1-26 are pending in the Application. All claims 1-26 have been rejected.

Claims 1-5 were rejected pursuant to 35 U.S.C. § 102(e) as being anticipated by Vak, et al. (US 5,473,143) ("Vak").

Claim 12 was rejected pursuant 35 U.S.C. § 103(a) as being unpatentable over Vak in view of Akel, et al. (US 5,457,305) ("Akel").

Claim 13 was rejected pursuant 35 U.S.C. § 103(a) as being unpatentable over Vak in view of Tsakanikas (US 5,570,465).

Claim 6 was rejected pursuant 35 U.S.C. § 103(a) as being unpatentable over Vak in view of Minematsu, et al. (US 4,864,109) ("Minematsu").

Claims 8-11, 14-16, and 18-19 were rejected pursuant 35 U.S.C. § 103(a) as being unpatentable over Vak in view of Wagner (U.S. Patent 5,742,845).

Claims 7, 17, and 20-26 were rejected pursuant 35 U.S.C. § 103(a) as being unpatentable over Vak in view of Wagner and Minematsu.

These rejections were the only rejections present in the Office Action ("Action") dated September 15, 2003. Appellants appeal the rejection of claims 1 through 26, inclusive.

## **STATUS OF AMENDMENTS**

No final rejection is pending. Prosecution has been reopened in response to Appellants' Appeal Brief filed June 10, 2003. Therefore, no amendments to the claims were requested to be admitted after a final rejection.

Appellants acknowledge the Office's implied admission that the previously appealed rejections (all based on Wagner, U.S. Patent 5,742,845) have been withdrawn because of the arguments presented in the Appeal Brief filed June 10, 2003. As shown in more detail herein, Appellants' claims are also allowable over the pending new grounds of rejection. The withdrawal of the previous rejections is reflective of the impropriety of the pending rejections. Thus, Appellants respectfully request reinstatement of their appeal pursuant to 37 C.F.R. § 1.193(b)(2).

## **SUMMARY OF INVENTION**

### Overview of the Invention

An exemplary form of the invention is directed to method and apparatus including an automated teller machine (ATM) (12). The ATM includes a computer (34) and transaction function devices (36), e.g., printer (46) and cash dispenser (42).

A transaction record (104) is stored in memory as data in an object in software. The object is used to accumulate data as an ATM transaction proceeds. The data stored in the transaction data object (104) may include data input through input devices (38, 40) by the ATM customer as well as data representative of operations carried out by transaction function devices.

Computer software that operates in the ATM includes a browser (76) that is operative to access markup language (e.g., HTML) documents through a server (88). The browser (76) can

process the accessed HTML documents. The HTML documents can include instructions to cause operation of the transaction function devices in the ATM. For example, an HTML document may include a cash dispense instruction that causes operation of the cash dispenser (42) (Specification page 34, lines 17-21). For further example, an HTML document may include a print instruction causing the printer (46) to print a customer's transaction receipt. The software which controls receipt printing can obtain the data used in printing the receipt from the transaction data stored in the transaction data object or record (104). Thus, the software can cause the printer to print a receipt responsive to the print instruction included in the accessed HTML document and the stored transaction data.

The operation of the exemplary software components enables selectively accessing HTML documents which produce different formats for printed items as well as using instructions contained in the HTML documents to include transaction data within the printed items. This enables printing items of varied types. For example, the arrangement can be used for printing receipts as well as for printing customer account statements and for printing a transaction journal within the ATM. The exemplary printing method also enables the printing of other various items, such as checks, wagering slips, coupons, marketing information, scrip, and travelers checks. The ATM can print a first item responsive to a print instruction in a first HTML document and print a second item responsive to a print instruction in a second HTML document.

Furthermore, different types of documents can be printed for different customers. For example, the arrangement enables providing printed formats in various languages (e.g., English) by using HTML documents which can provide printed forms in different languages. Thus, a first printed item can be of a first language and a second printed item can be of a second language.

Further description of an exemplary embodiment may be found at Specification page 73, line 11 through page 77, line 7, and Figure 31.

## **CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW**

The questions presented in this appeal are:

- 1). Whether Appellants' claims 1-5 are unpatentable under 35 U.S.C. § 102(e) as being anticipated by Vak.
- 2). Whether Appellants' claim 12 is unpatentable under 35 U.S.C. § 103(a) as being unpatentable over Vak in view of Akel.
- 3). Whether Appellants' claim 13 is unpatentable under 35 U.S.C. § 103(a) as being unpatentable over Vak in view of Tsakanikas.
- 4). Whether Appellants' claim 6 is unpatentable under 35 U.S.C. § 103(a) as being unpatentable over Vak in view of Minematsu.
- 5). Whether Appellants' claims 8-11, 14-16, and 18-19 are unpatentable under 35 U.S.C. § 103(a) as being unpatentable over Vak in view Wagner.
- 6). Whether Appellants' claims 7, 17, and 20-26 are unpatentable under 35 U.S.C. § 103(a) as being unpatentable over Vak in view of Wagner and Minematsu.

## **GROUPING OF CLAIMS**

No groups of claims stand or fall together. Reasons are provided in the Argument section herein. The arguments presented provide reasons why each of the claims are separately patentable. Appellants present for each respective separate claim a corresponding respective

separate argument as to why the claim is patentable over the rejection applied thereto. Each of Appellants' claims recites at least one element, combination of elements, or step not found or suggested in the applied references, which patentably distinguishes the claims.

The pending claims include eight independent claims (claims 1, 6, 14-15, 17-18, 21, and 25). Claims 2-5 and 8-13 depend from claim 1. Claim 7 depends from claim 6. Claim 16 depends from claim 15. Claims 19-20 depend from claim 14. Claims 22-24 depend from claim 21. Claim 26 depends from claim 25. All pending claims 1-26 are reproduced in the Appendix.

## **ARGUMENT**

### The Applicable Legal Standards

Anticipation pursuant to 35 U.S.C. § 102 requires that a single prior art reference contain all the elements of the claimed invention arranged in the manner recited in the claim. *Connell v. Sears, Roebuck & Co.*, 722 F.2d 1542, 1548, 220 USPQ 193, 198 (Fed. Cir. 1983).

Anticipation under 35 U.S.C. § 102 requires in a single prior art disclosure, each and every element of the claimed invention arranged in a manner such that the reference would literally infringe the claims at issue if made later in time. *Lewmar Marine, Inc. v. Barent, Inc.*, 822 F.2d 744, 747, 3 USPQ2d 1766, 1768 (Fed. Cir. 1987).

Anticipation by inherency requires that the Patent Office establish that persons skilled in the art would recognize that the missing element is necessarily present in the reference. To establish inherency the Office must prove through citation to prior art that the feature alleged to be inherent is "necessarily present" in a cited reference. Inherency may not be established based on probabilities or possibilities. It is plainly improper to reject a claim on the basis of 35 U.S.C.

§ 102 based merely on the possibility that a particular prior art disclosure could or might be used or operated in the manner recited in the claim. *In re Robertson*, 169 F.3d 743, 49 U.S.P.Q. 2d 1949 (Fed. Cir. 1999).

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellant is under no obligation to submit evidence of nonobviousness. MPEP § 2142.

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembicza*k, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

A determination of patentability must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

### **The Vak Reference**

Vak is directed to an electronic mail system that uses ATM or POS (point of sale) network terminals. Vak apparently relates to an early type of e-mail service using store and forward message technology at a time (i.e., pre-Internet with proprietary systems) when "there exists no widely available means by which the public or private can conveniently and inexpensively access electronic mail communication" (col. 1, lines 35-45).

Vak desires that a user be able to receive and transmit electronic messages to other users by using an ATM or POS terminal. The system can use existing ATM or POS networks (col. 15, lines 53-57; col. 1, lines 55-61), such as EFT networks (col. 2, lines 10-17; col. 1, lines 48-54). A message service control function differentiates the e-mail messages from the financial transactions normally exchanged over the network (col. 2, lines 56-60). That is, Vak apparently keeps separate the e-mail messages from any ATM transaction message.

Figure 1 shows an ATM or POS terminal (22, 24; 26, 28; 34) and a processor (18; 36) connected to a clearing house data network (42) and clearing house network processor (44). An ATM data network (16) and POS data network (38) are also shown. In the electronic mail system (10), messages can be stored or retrieved through an ATM or POS terminal.

During operation (col. 5, line 16 to col. 6, line 4) a user inserts a debit or credit card (48) into an ATM (or POS) terminal. The terminal, in conjunction with a local microprocessor, acquires the user's identity and security information. After the user enters a PIN, the ATM terminal communicates through its own (proprietary) ATM communication network (16), institution processor (18), and clearing house network (42) with the clearing house network processor (44). The clearing house network processor (44) then interacts with the user's financial institution processor (46) to access the user's account, to obtain user authorization for electronic mail access, and to acquire user fee information. After receiving user access authorization for the electronic mail system (10), the clearing house network processor (44) then activates its message service control function to access, via the clearing house network (42), stored messages for the user that may be stored on a store and forward message switch (52). Via the clearing house network (42) the switch (52) then sends the stored messages back to the user's ATM terminal. The user may also respond to or originate messages for storage on the store and forward message switch (52) using the ATM terminal in the same manner as in requesting access to stored messages.

### The Akel Reference

Akel is directed to a transaction processing system (10). The system (10) enables a customer to obtain cash via their credit card. The system (10) consists of a customer data-input station (14), a customer service station (16), and a customer transaction booth (20). A customer can input a credit card and request an amount of cash at the customer data-input station (14). The transaction request is sent to the customer service station (16). At the station (16), the transaction

is processed and sent to a credit card processing center (18). If an approval is given, a check corresponding to the approved amount, is printed with a printer (16C) located in the customer service station (16). The check is given to the customer at the customer transaction booth (20), where the check can be converted into cash upon proper identification.

#### **The Tsakanikas Reference**

Tsakanikas is directed to a global network computer system to print legal currency and/or negotiable instruments at a designated location by the input of information to the global network computer system from a remote location (10). The global network computer system can receive the input information from a telephone handset (14) or terminal (12) using a technique of selective generation of signals. Output signals from the global network computer can be sent to designated facsimile machines, laser printers, telecopiers, or automated teller machines for printing (32) the legal currency or negotiable instrument. The global network is also capable of storing and tracking greenback currency provided with a unique barcode.

#### **The Minematsu Reference**

Minematsu is directed to a transaction system including a card-shaped electronic bankbook and a transaction device. The electronic bankbook is intended to replace a paper bankbook (col. 1, lines 16-49). The electronic bankbook includes an IC chip encapsulated in an insulating card substrate (10). The IC chip comprises a CPU (1), data memories (3, 4), display (5), a key switch (6), a power supply (8, 9), and an interface (7) for receiving or delivering a signal from or to a transaction device. The system has a crime prevention function where

transactions are made invalid if identification information is erroneously entered a prescribed number of times. The electronic bankbook (IC card) is issued for a customer by a banking organ (col. 5, lines 50-52).

### **The Wagner Reference**

Wagner is directed to a system for extending present open network communication protocols to communicate with non-standard I/O devices coupled to an open network. The system (10) includes a Web server (12) which is coupled to an open network (14) such as the Internet for communication with various non-standard I/O devices (16, 18, 20, 32, 34, 36, 38) (Figure 1; col. 9, line 63 to col. 10, line 1). The system permits a consumer to collect product information by using an open network, such as the Internet, and then use a more secure transaction link for the transaction (col. 6, lines 12-16; col. 18, lines 26-36). A client program executes in a non-standard I/O device (col. 10, lines 52-54). For a payment transaction the client program is suspended and control is transferred to a conventional bank processing application. Printer (38) prints a purchase agreement form (e.g., charge slip) for the customer's signature (col. 5, lines 3-8; col. 18, lines 33-36; col. 19, lines 27-28). Thus, a conventional secure proprietary transaction system for authorization and settlement can be maintained (col. 11, lines 58-65).

The system permits a user to use the open network for non-confidential communication such as collecting product information, pricing, and product availability. This information may be collected quickly and efficiently using the extended Internet protocol. The conventional bank processing program and more secure communication links may then be used for the confidential information required to carry out the transaction. Thus, Wagner seeks to combine the features

and advantages of the Internet with the more secure communication link and data security enhancing devices of systems presently known (col. 7, lines 15-25).

**(iii) 35 U.S.C. § 102**

In the Action claims 1-5 were rejected under 35 U.S.C. § 102(e) as being anticipated by Vak. These rejections are respectfully traversed.

Appellants respectfully disagree with the Action's interpretation and application of Vak. Vak does not teach each and every feature, relationship, and step of the claimed invention arranged in the manner recited in the claims, as is required to sustain the rejections. It follows that Vak cannot anticipate the claims. Thus, it is respectfully submitted that the 35 U.S.C. § 102(e) rejections should be withdrawn.

**Claim 1**

Vak does not teach the recited method of printing a document with an automated banking machine. For example, Vak does not teach at least the recited steps (c) and (d).

**Vak does not teach step (c)**

The Action alleges (in paragraph number 3) that Vak teaches step (c) at col. 5, lines 60-67; col. 18, lines 20-54; and col. 21, lines 16-30. The Appellants respectfully disagree. Vak does not teach a markup language document or a browser. Both a markup language (e.g., HTML) document and a browser have well known meaning in the art (e.g., Microsoft Computer Dictionary). Nor does Vak teach accessing a markup language document with a browser. Nor does Vak teach that the markup language document includes at least one print instruction. As discussed in the description thereof, Vak is directed to an antiquated (i.e., pre-Internet with

proprietary systems) type of e-mail service using store and forward message technology. Vak is not directed to a method that includes accessing a markup language document with a browser operating in a computer associated with an automated banking machine.

The Action's relied upon section in col. 5 of Vak states:

By interacting with the terminal 22, 24, 26, 28 or 34 through a keyboard and/or function keys illustrated in FIG. 2, a user directs the ATM/POS subsystem 14 to display the retrieved messages on a display screen, also illustrated in FIG. 2. Using the keyboard and/or function keys of the terminal 22, 24, 26, 28 or 34, the user may request that the terminal 22, 24, 26, 28, or 34 print a copy of a retrieved message on paper 54.

Where does Vak teach accessing a markup language document with a browser, especially a markup language document including a print instruction? Rather the relied upon section relates to displaying electronic mail messages. Furthermore, Vak teaches that it is the user that instructs (requests) the terminal to print a copy of the electronic mail message. That is, Vak does not teach that a markup language document includes a print instruction.

The Action's relied upon section in col. 18 of Vak states that "A user may choose to have the printer subsystem 160 print a message on the paper 54." This section further confirms the previously discussed relied upon col. 5 section. That is, in Vak a copy of an electronic mail message is printed responsive to a user's instruction to the terminal, not responsive to a print instruction in a markup language document.

The Action's relied upon section in col. 21 of Vak relates to a non analogous translation function which utilizes commercially available language translation algorithms. Again, Vak does

not teach the specifically recited features and relationships of step (c). It follows that Vak cannot anticipate claim 1.

Vak does not teach step (d)

The Action alleges (in paragraph number 3) that Vak teaches step (d) at col. 10, lines 22-41. The Appellants respectfully disagree. Vak does not teach printing (with a printer in an automated banking machine) indicia corresponding to transaction data stored in memory responsive to a print instruction included in a markup language document accessed with a browser. Where does Vak cause stored transaction data to be printed in response to a print instruction in a browser-accessed markup language document? As previously discussed in the description thereof, Vak keeps the e-mail messages differentiated from the financial transactions (and ATM transaction data). As previously discussed, Vak's printer (160) is able to print these e-mail messages in response to a user's instruction. Vak does not teach the recited relationships of a markup language document, a browser, transaction data in memory, an automated banking machine printer, or a markup language document print instruction. Vak does not teach the specifically recited features and relationships of step (d). Again, Vak cannot anticipate claim 1.

The Appellants would also like to point out that claim 21 is directed to computer readable media bearing instructions that are operative to cause an automated banking machine to carry out the method steps of claim 1. However, the rejection of claim 21 relies on Vak in view of Wagner and Minematsu. That is, by inference the Office admits that Vak cannot anticipate the recited method steps.

Appellants have shown that the Vak reference does not teach every feature, relationship, and step arranged in the manner recited in claim 1, as is required to sustain the rejection. Thus, Appellants respectfully submit that the rejection of claim 1 is improper and should be withdrawn.

### **Claim 2**

Claim 2 depends from claim 1. Vak further does not teach a markup language document including instructions corresponding to a format. Nor does Vak teach that in step (d) the indicia is printed in accordance with the format. As previously discussed, Vak does not even teach a markup language document. Vak does not teach or suggest printing indicia in accordance with instructions in a markup language document which corresponds to a format. It follows that Vak does not anticipate claim 2.

### **Claim 3**

Claim 3 depends from claim 1. Vak further does not teach storing in memory transaction data including inputted customer identifying information. Vak does not anticipate claim 3.

### **Claim 4**

Claim 4 depends from claim 3. Vak further does not teach storing in memory transaction data including customer identifying information that corresponds to indicia read by a card reader from an inputted card. Vak does not anticipate claim 4.

### **Claim 5**

Claim 5 depends from claim 1. Where does Vak print indicia corresponding to a transaction that includes the dispense of a sheet from an automated banking machine sheet dispenser? Vak does not teach conducting a transaction that includes the dispense of a sheet

from an automated banking machine sheet dispenser in the manner recited. Vak does not anticipate claim 5.

**(iv) 35 U.S.C. § 103**

Appellants traverse the rejections on the grounds that Appellants' claims recite features, relationships, and/or steps which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' recited invention. The features, relationships, and/or steps recited in Appellants' claims patentably distinguish over the applied references. Nor would it have been obvious to one having ordinary skill in the art to have combined the teachings of the references to have produced the recited invention.

The Office does not factually support any *prima facie* conclusion of obviousness. To establish *prima facie* obviousness, the prior art must teach or suggest all the claim limitations. If the Office does not produce a *prima facie* case, which is the current situation, then the Appellants are under no obligation to submit evidence of nonobviousness (MPEP § 2142).

The Appellants respectfully disagree with the Action's interpretation of the applied references. Even if it were somehow possible (which it isn't) for the Action to show (which it doesn't) that all of the recited features were known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, *supra*. *In re Newell*, *supra*. Without any prior art showing of a motivation to combine, which is the current situation, a rejection based on a *prima facie* case of obviousness is improper (MPEP § 2143.01).

The Action does not provide any teaching, suggestion, or motivation in the prior art to modify the Vak reference in the manner alleged. Thus, it would not have been obvious to one having ordinary skill in the art to have modified Vak to have produced Appellants' claimed invention. Furthermore,

Nor does the Action explain how Vak could be modified. Since the Action does not explain the rejections with reasonable specificity, it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989).

The Appellants respectfully submit that the attempts to combine teachings are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejections, which lack the necessary evidence and rationale, are based on knowledge gleaned only from Appellants' disclosure. It follows that it would not have been obvious to have modified the Vak reference in the manner alleged.

Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejections are improper and should be withdrawn.

**Claim 12 Is Not Obvious Over  
Vak in view of Akel**

Claim 12 was rejected pursuant 35 U.S.C. § 103(a) as being unpatentable over Vak in view of Akel. This rejection is respectfully traversed.

### **Claim 12**

Claim 12 depends from claim 1. The Action admits (at paragraph number 8) that Vak does not teach or suggest a printer that is operative to print a check. Thus, Vak does not teach or suggest printing indicia corresponding to transaction data with an automated banking machine printer that is operative to print a check. Akel cannot alleviate the deficiencies of Vak as it does not disclose or suggest the recited features and relationships which are not found in Vak.

Akel does not teach or suggest printing indicia corresponding to stored transaction data with an automated banking machine check printer responsive to a print instruction included in a browser-accessed markup language document. The Office has not established a *prima facie* showing of obviousness. Furthermore, the motivation provided in the Action for modifying Vak is unclear. It is unclear how printing a check produces proof of a transaction. It would not have been obvious to one having ordinary skill in the art to have modified Vak with the alleged teaching of Akel to have produced the recited method.

### **Claim 13 Is Not Obvious Over Vak in view of Tsakanikas**

Claim 13 was rejected pursuant 35 U.S.C. § 103(a) as being unpatentable over Vak in view of Tsakanikas. This rejection is respectfully traversed.

### **Claim 13**

Claim 13 depends from claim 1. The Action admits (at paragraph number 4) that Vak does not teach or suggest a printer that is operative to print a wagering slip. Thus, Vak does not teach or suggest printing indicia corresponding to transaction data with a printer that is operative

to print a wagering slip. Tsakanikas cannot alleviate the deficiencies of Vak as it does not disclose or suggest the recited features and relationships which are not found in Vak.

Tsakanikas is not directed to printing a wagering slip with an automated banking machine. Where does Tsakanikas teach or suggest a printer capable of printing a wagering slip? Where does Tsakanikas even mention printing a wagering slip? Tsakanikas does not teach or suggest printing indicia corresponding to stored transaction data with an automated banking machine wagering slip printer responsive to a print instruction included in a browser-accessed markup language document.

The Office has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified Vak with the alleged teaching of Tsakanikas to have produced the recited method.

**Claim 6 Is Not Obvious Over  
Vak in view of Minematsu**

In the Action claim 6 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Vak in view of Minematsu. This rejection is respectfully traversed.

**Claim 6**

The Appellants respectively traverse the rejection and the assertions made therein. Note Appellants' above remarks in support of the patentability of claim 1. Neither Vak nor Minematsu, taken alone or in combination, teach or suggest the recited features and relationships.

Vak does not teach or suggest the recited features and relationships of the recited automated banking machine. The Action admits (in paragraph number 6) that Vak does not

teach or suggest a cash dispenser. The Action further admits that Vak does not teach or suggest software that is operative to store cash dispenser transaction data. However, Appellants respectively submit that Vak further does not teach or suggest other recited features and relationships. For example, Vak does not teach or suggest software that is operative to cause the access of a markup language document that includes a print instruction. Note Appellants' claim 1 remarks. Nor does Vak teach or suggest software that is operative to cause an automated banking machine printer to print an item that includes indicia representative of at least one portion of transaction data responsive to the markup language document print instruction and the cash dispenser transaction data stored in memory.

Minematsu cannot alleviate the deficiencies of Vak as it does not disclose or suggest the recited features and relationships which are not found in Vak. Claim 6 is directed to an automated banking machine comprising a computer, printer, cash dispenser, and software executable in the computer. Minematsu is directed to an electronic bankbook comprising an IC card. The electronic bankbook is intended to replace a paper bankbook (col. 1, lines 16-49). An interface (7) can connect the IC card CPU (1) to a transaction device. An automated banking machine does not comprise Minematsu's electronic bankbook, but rather the electronic bankbook (IC card) is issued for a customer by a banking organ (col. 5, lines 50-52). Minematsu's electronic bankbook CPU (1) does not constitute an automated banking machine computer, especially in light of the Action's reference to Clark regarding the alleged ability of a machine to dispense cash. Thus, Minematsu's electronic bankbook (and the features thereof) is non analogous to an automated banking machine.

Vak admittedly does not teach or suggest a cash dispenser. Vak admittedly does not teach or suggest the recited software. Minematsu does not teach or suggest the recited automated banking machine software. Minematsu's electronic bankbook (and any software therein) is also non analogous to the recited automated banking machine software. Neither Vak nor Minematsu, taken alone or in combination, teach or suggest the recited automated banking machine software, especially software that is operative to: cause storage in memory of cash dispenser transaction data; cause access to a markup language document that includes a print instruction; cause an automated banking machine printer to print an item that includes indicia representative of at least one portion of transaction data responsive to the markup language document print instruction and the cash dispenser transaction data stored in memory.

Where do the references teach or suggest automated banking machine software that is operative to cause an automated banking machine computer to access at least one markup language document that includes a print instruction? Where do the references teach or suggest that the automated banking machine software is further operative to cause a printer to print indicia corresponding to transaction data responsive to the print instruction and the stored transaction data? Where do the references teach or suggest software that is (responsive to a markup language document print instruction and stored cash dispenser transaction data) capable of causing a printer to print cash dispenser transaction data indicia?

Appellants respectfully submit that in light of the failure of the applied references to teach or suggest all of the recited features and relationships, combined with the lack of any other supporting evidence of record, the rejection is not valid. *In re Lee*, supra. *In re Zurko*, supra.

The Office does not factually support any *prima facie* conclusion of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified Vak with the alleged teachings of Minematsu to have produced the recited invention. Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claim 6 should be withdrawn.

**The Pending Claims Are Not Obvious Over  
Vak in view of Wagner**

In the Action independent claims 8-11, 14-16, and 18-19 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Vak in view of Wagner. The rejections are respectfully traversed. The Appellants respectfully disagree with the Action's interpretation and application of the applied references. The Appellants also respectfully disagree with the assertions that the relied upon sections of the references teach or suggest the recited features. The Appellants respectfully submit that neither Vak nor Wagner, taken alone or in combination, teach or suggest the recited features and relationships. Additionally, even if it were somehow possible for the references to have disclosed certain features as alleged, it still would not have been obvious to one having ordinary skill in the art to have combined the references as alleged, especially to have produced the recited invention.

The Action's reliance on Wagner falls short of the actual teaching thereof. As previously mentioned, Appellants successfully rebutted all of the previous rejections relying on Wagner in the Appeal Brief filed June 10, 2003. That is, all of the previously appealed rejections relying on Wagner had been withdrawn by the Office. Appellants respectfully submit that the teaching of

Wagner remains fixed and continues to be insufficient in the same manner that caused the Office to withdrawal the previous appealed rejections.

### **Claim 8**

Claim 8 depends from claim 1. The Action admits (in paragraph number 7) that Vak does not teach or suggest steps (e), (f), and (g).

Wagner also does not teach or suggest steps (e), (f), and (g). For example, Wagner does not teach or suggest both printing indicia corresponding to stored transaction data with an automated banking machine printer responsive to a print instruction included in a browser-accessed first markup language document, and printing indicia corresponding to stored transaction data with the automated banking machine printer responsive to a second print instruction in a browser-accessed second markup language document. Where does Wagner teach or suggest using an automated banking machine printer to print first and second indicia related to transaction data stored in memory, especially responsive to print instructions in browser-accessed first and second markup language documents? Wagner's printer (38) is directed to printing a purchase agreement form (e.g., charge slip) for the customer's signature (col. 5, lines 3-8; col. 18, lines 33-36; col. 19, lines 27-28) in order to permit a transaction to occur. The evidence of record does not teach or suggest the recited features. *In re Zurko*, supra. Nor has the Office established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified Vak with the alleged teachings of Wagner to have produced the recited method. X

### Claim 9

Claim 9 depends from claim 8. Wagner further does not teach or suggest a first markup language document including indicia in a first language and a second markup language document including indicia in a second language. It follows that Wagner does not teach or suggest both producing a printed item with transaction indicia in a first language and producing a printed item with transaction indicia in a second language. It further follows that Wagner cannot alleviate the deficiencies of Vak. Thus, even if it were somehow possible (which it isn't) for Vak to be combined with the teachings of Wagner, it would not have resulted in the recited method.

### Claim 10

Claim 10 depends from claim 1. The Action admits that Vak does not teach or suggest a browser-accessed markup language document including indicia representative of machine readable indicia, nor producing a printed item including machine readable indicia. Wagner does not teach or suggest a markup language document including indicia representative of machine readable indicia. Nor does Wagner teach or suggest printing an item including machine readable indicia. It follows that the Office has not established a *prima facie* showing of obviousness.

### Claim 11

Claim 11 depends from claim 1. The Action admits that Vak does not teach or suggest a transaction receipt printer. Wagner further does not teach or suggest printing indicia corresponding to transaction data with a printer that is operative to print a transaction receipt. Where does Wagner teach or suggest a printer capable of printing a receipt? Where does Wagner even mention printing a receipt? As previously discussed, Wagner's printer (38) is directed to

printing a purchase agreement form (e.g., charge slip) for the customer's signature (col. 5, lines 3-8; col. 18, lines 33-36; col. 19, lines 27-28) in order to permit a transaction to occur.

The relied upon section of Wagner at col. 19, lines 19-28 does not teach or suggest the recited features as alleged. The "transaction record" referred to in Wagner is not a transaction receipt, but rather a transaction form requiring the customer's signature. Note Wagner's Figure 14, which corresponds to the relied upon section of Wagner. Appellants respectfully submit that the Action's assertion of obviousness is not based on any evidence in the record. *In re Zurko*, supra. The Office has not established a *prima facie* showing of obviousness.

#### **Claim 14**

The Appellants respectively traverse the rejection and the assertions made therein. Note Appellants' above remarks in support of the patentability of claims 1 and 6.

The Appellants respectfully submit that neither Vak nor Wagner, taken alone or in combination, teach or suggest the recited features and relationships. The references, taken alone or in combination, do not teach or suggest the recited relationships of the transaction function devices, computer, and software. For example, the references do not teach or suggest automated banking machine software that is operative to cause a browser to access a markup language document having a print instruction and to operate a printer to print an item responsive to the print instruction and transaction data. Where do the references teach or suggest software that is operative to cause a browser to access a markup language document? Where do the references even mention a browser? Where do the references teach or suggest causing a printer to print an item responsive to a print instruction included in a markup language document and stored transaction data?

The references, taken alone or in combination, do not teach or suggest automated banking machine including software that:

- 1) includes a browser;
- 2) is operative to cause an automated banking machine computer to store in memory transaction data representative of at least one input to an input device;
- 3) is operative to cause a browser to access a markup language document including at least one print instruction; and
- 4) is operative to cause an automated banking machine printer to print an item responsive to the print instruction in the browser-accessed markup language document and the transaction data.

The references, taken alone or in combination, do not teach or suggest printing an item responsive to both a print instruction in a browser-accessed markup language document and transaction data stored in memory by the software, especially where the transaction data is representative of input to an automated banking machine input device.

The Office has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified Vak with the alleged teachings of Wagner to have produced the recited apparatus. Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claim 14 should be withdrawn.

### **Claim 15**

The Appellants respectively traverse the rejection and the assertions made therein. Note Appellants' above remarks in support of the patentability of claims 1, 6, and 14.

The Appellants respectfully submit that neither Vak nor Wagner, taken alone or in combination, teach or suggest the recited features and relationships of the recited automated banking machine. The references, taken alone or in combination, do not teach or suggest the recited relationships of the transaction function devices, computer, and software.

As discussed previously, the references do not teach or suggest software in an automated banking machine which is operative to cause a printer to print a first item responsive to both a first print instruction (included in a markup language document) and at least a portion of transaction data stored in a memory by the software, where the transaction data is representative of at least one input to an input device of the automated banking machine. In addition, the references do not teach or suggest that such software is operative to cause the printer to print a second item responsive to a second print instruction (included in a second markup language document) and at least a portion of the transaction data stored in the memory.

The references do not teach or suggest software that is operative to cause a printer to print a first item responsive to a first markup language document print instruction and transaction data, and is operative to cause the printer to print a second item responsive to a second markup language document print instruction and transaction data. Where do the references teach or suggest enabling the same automated banking machine printer to print first and second items related to the same transaction, especially in response to print instructions in browser-accessed first and second markup language documents?

The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified Vak with the alleged

teachings of Wagner to have produced the recited apparatus. Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claim 15 should be withdrawn.

**Claim 16**

Claim 16 depends from claim 15. The Action relies on Wagner for the alleged teaching. However, Wagner does not teach or suggest a first markup language document including indicia in a first language and a second markup language document including indicia in a second language. Nor does Wagner teach or suggest both a first printed item with transaction data indicia in a first language and a second printed item with transaction data indicia in a second language. The Office has not established a *prima facie* showing of obviousness. It follows that it would not have been obvious to one having ordinary skill in the art to have modified Vak with the alleged teachings of Wagner to have produced the recited apparatus.

**Claim 18**

The Appellants respectively traverse the rejection and the assertions made therein. Note Appellants' above remarks in support of the patentability of claims 1, 6, 14, and 15.

The Appellants respectfully submit that neither Vak nor Wagner, taken alone or in combination, teach or suggest the recited features and relationships of the recited automated banking machine. The references, taken alone or in combination, do not teach or suggest the recited relationships of the transaction function devices, computer, and software.

As discussed previously, the references do not teach or suggest software in an automated banking machine which is operative to print responsive to both a print instruction in a markup language document and transaction data.

Further, nowhere in Vak or Wagner is it disclosed or suggested, that an automated banking machine includes software that is operative to cause an automated banking machine printer to print a wagering slip. The Action admits (in the rejection of claim 13) that Vak does not teach or suggest a printer that is operative to print a wagering slip. Where do the references teach or suggest an automated banking machine printer capable of printing a wagering slip? Where do the references even mention printing a wagering slip? Appellants respectfully submit that in light of the failure of the applied references to teach or suggest all of the recited features and relationships, combined with the lack of any other supporting evidence of record, the rejection is not valid. *In re Lee*, supra. *In re Zurko*, supra.

Further, nowhere in the references is it disclosed or suggested that an automated banking machine includes software that is operative to cause a printer to print a wagering slip responsive to a print instruction in a browser-accessed markup language document and transaction data. The references do not teach or suggest software that is operative to cause an automated banking machine printer to print a wagering slip responsive to a markup language document print instruction.

Furthermore, the Action indicates that the rejection of claim 18 is rejected by "the same rationale" as the rejection of claim 13. As previously discussed, in the rejection of claim 13 the Action admits that Vak does not teach or suggest a printer that is operative to print a wagering slip. The rejection of claim 13 relied on Tsakanikas for the alleged wagering slip printer teaching. However, Tsakanikas is not applied in the rejection of claim 18. Thus, by inference the Office admits that the applied references do not teach or suggest the recited features and relationships.

Again, the evidence of record does not teach or suggest the recited features. *In re Zurko*, supra. The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to have modified Vak with the (inadequate) teachings of Wagner to have produced the recited apparatus. Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claim 18 should be withdrawn.

**Claim 19**

Claim 19 depends from claim 14. As previously discussed (e.g., claim 2 remarks), Vak does not teach or suggest markup language document instructions corresponding to a format. Wagner does not teach or suggest software that is operative to cause an automated banking machine printer to print an item responsive to a markup language document print instruction and transaction data. Nor does Wagner teach or suggest that indicia is printed on the item in accordance with format instructions in the browser-accessed markup language document. It follows that the Office has not established a *prima facie* showing of obviousness.

**The Pending Claims Are Not Obvious Over  
Vak in view of Wagner and Minematsu**

In the Action independent claims 7, 17, and 20-26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Vak in view of Wagner and Minematsu. The rejections are respectfully traversed. The Appellants respectfully disagree with the Action's interpretation and application of the applied references. The Appellants also respectfully disagree that the relied upon sections of the references include the alleged teachings. The Appellants respectfully submit that neither Vak nor Wagner nor Minematsu, taken alone or in combination, teach or suggest the

recited features and relationships. Additionally, it would not have been obvious to one having ordinary skill in the art to have combined the references as alleged, especially to have produced the recited invention.

Also, as previously discussed, Appellants respectfully submit that the teaching of Wagner continues to be insufficient in the same manner that caused the Office to withdrawal (in response to the Appeal Brief filed June 10, 2003) the previous appealed rejections.

**Claim 7**

Claim 7 depends from claim 6. Claim 7 recites that the at least one markup language document includes at least one print instruction but not the transaction data portion. The Action admits that Vak/Minematsu does not teach or suggest having a markup language document without transaction data. The Action alleges that Wagner teaches the features at col. 14, lines 25-31. The Appellants respectfully disagree.

The Appellants respectfully submit that Wagner does not teach or suggest a markup language document that includes a print instruction but not transaction data. Where does Wagner teach or suggest a markup language document that includes a print instruction, yet does not include transaction data? The Office has not established a *prima facie* showing of obviousness. Even if it were somehow possible (which it isn't) for Vak/Minematsu to be combined with the teachings of Wagner, it still would not have resulted in the recited apparatus.

**Claim 17**

The Appellants respectively traverse the rejection and the assertions made therein. Note Appellants' above remarks in support of the patentability of claims 1, 6, 14, and 15.

The Appellants respectfully submit that neither Vak nor Wagner nor Minematsu, taken alone or in combination, teach or suggest the recited features and relationships of the recited automated banking machine. The references, taken alone or in combination, do not teach or suggest the recited relationships of the transaction function devices, computer, and software.

The references do not teach or suggest an automated banking machine that includes software that is operative to cause an automated banking machine printer to print a check responsive to a print instruction in a markup language document and transaction data. The references do not teach or suggest software that is operative to cause a printer to print a check responsive to a markup language document print instruction. Where do the references teach or suggest a printer capable of printing a check? Where do the references even mention printing a check?

Furthermore, the Action indicates that the rejection of claim 17 follows "the same rationale" as the rejection of claim 12. In the rejection of claim 12 the Action admits that Vak does not teach or suggest a printer that is operative to print a check. The rejection of claim 12 relied on Akel for the alleged check printer teaching. However, Akel is not applied in the rejection of claim 17. Thus, by inference the Office admits that the applied references do not teach or suggest the recited features and relationships.

The evidence of record does not teach or suggest the recited features. *In re Zurko*, supra. Nor has the Office established a *prima facie* showing of obviousness. Nor would it have been obvious to have modified Vak with the alleged teachings of Wagner and Minematsu to have produced the recited apparatus. Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claim 17 should be withdrawn.

## **Claim 20**

Claim 20 depends from claim 14. The Action admits that Vak/Wagner does not teach or suggest having a cash dispenser nor software operative to cause the cash dispenser to dispense an amount of cash. The Action relies on Minematsu as allegedly teaching the recited features absent in Vak/Wagner. The Appellants respectfully disagree.

Minematsu does not teach or suggest the recited software executable in a computer of an automated banking machine, especially where the software:

- 1) includes a browser;
- 2) is operative to cause the computer to store transaction data representative of input to a machine input device in memory;
- 3) is operative to cause the browser to access a markup language document having a print instruction;
- 4) is operative to cause a machine printer to print an item responsive to the print instruction (in the browser-accessed markup language document) and the transaction data; and
- 5) is further operative to cause a machine cash dispenser to dispense an amount of cash.

It follows that the Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified Vak/Wagner with the alleged teaching Minematsu to have produced the recited apparatus.

### **Claim 21**

The Appellants respectively traverse the rejection and the assertions made therein. The Appellants respectfully submit that neither Vak nor Wagner nor Minematsu, taken alone or in combination, teach or suggest the recited features and relationships.

Claim 21 is directed to computer readable media bearing instructions. The instructions are operative to cause at least one computer in an automated banking machine to cause the automated banking machine to carry out method steps, which correspond to the method steps recited in claim 1. Note Appellants' above remarks in support of claim patentability, especially the patentability of claim 1.

The references do not teach or suggest either the steps nor computer readable media having the ability to cause an automated banking machine to perform the steps. The references do not teach or suggest accessing a markup language document with a browser, especially a markup language document including a print instruction. The references do not teach or suggest printing (with an automated banking machine printer) indicia corresponding to stored transaction data in response to a print instruction in a browser-accessed markup language document. It follows that the Office has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified Vak with the alleged teachings of Wagner and Minematsu to have produced the recited invention.

### **Claim 22**

Claim 22 depends from claim 21. The references, taken alone or in combination, do not teach or suggest computer readable media bearing instructions which are operative to cause the at least one computer to cause an automated banking machine to perform the steps (e), (f), and (g).

For example, the references, taken alone or in combination, do not teach or suggest both printing indicia corresponding to transaction data with an automated banking machine printer responsive to a print instruction included in a first markup language document, and printing indicia corresponding to the transaction data with the automated banking machine printer responsive to a second print instruction in a second markup language document. Where do the references teach or suggest using the same automated banking machine printer to print first and second indicia related to stored transaction data, especially responsive to print instructions in browser-accessed first and second markup language documents? The evidence of record does not teach or suggest the recited features. *In re Zurko*, supra. Nor has the Office established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified Vak with the alleged teachings of Wagner and Minematsu to have produced the recited invention.

### **Claim 23**

Claim 23 depends from claim 21. The references, taken alone or in combination, do not teach or suggest computer readable media bearing instructions which are operative to cause an automated banking machine check printer to print indicia corresponding to transaction data. Where do the references even mention printing a check? As previously discussed, Wagner's printer (38) is for printing a purchase agreement form for the customer's signature.

Furthermore, the Action indicates that the rejection of claim 23 follows "the same rationale" as the rejection of claim 12. In the rejection of claim 12 the Action admits that Vak does not teach or suggest a check printer. The rejection of claim 12 relied on Akel for the alleged check printer teaching. However, Akel is not applied in the rejection of claim 23. Thus, by

inference the Office admits that the applied references do not teach or suggest the recited features and relationships.

Appellants respectfully submit that the Action's assertion of obviousness is not based on any evidence in the record. *In re Zurko*, supra. The Office has not established a *prima facie* showing of obviousness.

#### **Claim 24**

Claim 24 depends from claim 21. The references, taken alone or in combination, do not teach or suggest computer readable media bearing instructions which are operative to cause an automated banking machine wagering slip printer to print indicia corresponding to transaction data. Where do the references even mention printing a wagering slip? As previously discussed, Wagner's printer (38) is for printing a purchase agreement form for the customer's signature.

Furthermore, the Action indicates that the rejection of claim 24 is rejected by "the same rationale" as the rejection of claim 13. As previously discussed, in the rejection of claim 13 the Action admits that Vak does not teach or suggest a printer that is operative to print a wagering slip. The rejection of claim 13 relied on Tsakanikas for the alleged wagering slip printer teaching. However, Tsakanikas is not applied in the rejection of claim 24. Thus, by inference the Office admits that the applied references do not teach or suggest the recited features and relationships.

Appellants respectfully submit that the Action's assertion of obviousness is not based on any evidence in the record. *In re Zurko*, supra. The Office has not established a *prima facie* showing of obviousness.

### Claim 25

Note Appellants' above remarks in support of the patentability of claims 1, 6, 14, 15, 17, 18, and 21. The Appellants respectfully submit that neither Vak nor Wagner nor Minematsu, taken alone or in combination, teach or suggest the recited features and relationships of the recited method of printing a document with an automated banking machine.

The Appellants respectfully submit that the references do not teach or suggest printing (with an automated banking machine printer) an item corresponding to cash dispense transaction data stored in memory responsive to a markup language document print instruction and the transaction data stored in the memory.

The references do not teach or suggest storing in a memory, transaction data corresponding to a transaction involving the dispense of cash. In addition, the references do not teach or suggest printing indicia representative of at least a portion of the stored cash dispense transaction data responsive to both a print instruction in the markup language document and the stored transaction data.

The Office does not factually support any *prima facie* conclusion of obviousness. The references do not teach or suggest the recited features and relationships. It would not have been obvious to one having ordinary skill in the art to have modified Vak with the alleged teachings of Wagner and Minematsu to have produced the recited method. Thus, it is respectfully submitted that the 35 U.S.C. § 103(a) rejection of claim 25 should be withdrawn.

### Claim 26

Claim 26 depends from claim 25. Claim 26 recites that the at least one markup language document includes a print instruction but not the transaction data portion. The Action indicates

that claim 26 is rejected by "the same rationale" as the rejection of claim 7. As previously discussed, in the rejection of claim 7 the Action admits that Vak/Minematsu does not teach or suggest having a markup language document without transaction data. The Action relies on Wagner at col. 14, lines 25-31. The Appellants respectfully disagree.

The Appellants respectfully submit that Wagner does not teach or suggest a markup language document that includes a print instruction but not transaction data. Where does Wagner teach or suggest a markup language document that includes a print instruction, yet does not include transaction data? The Office has not established a *prima facie* showing of obviousness. Even if it were somehow possible (which it isn't) for Vak/Minematsu to be combined with the teachings of Wagner, it still would not have resulted in the recited method.

## CONCLUSION

Each of Appellants' pending claims specifically recites features, relationships, and/or steps that are neither disclosed nor suggested in the applied art. Furthermore, the applied art is devoid of any teaching, suggestion, or motivation for combining features of the applied art so as to produce the recited invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



Ralph E. Jocke  
WALKER & JOCKE  
231 South Broadway  
Medina, Ohio 44256  
(330) 721-0000

Reg. No. 31,029

## **APPENDIX**

### **CLAIMS**

1. A method of printing a document with an automated banking machine, comprising the steps of:
  - (a) conducting at least one transaction with the machine;
  - (b) storing transaction data corresponding to the transaction in a memory in operative connection with a computer, wherein the computer is operatively connected with the machine;
  - (c) accessing a first markup language document with a browser operating in the computer, wherein the first markup language document includes at least one print instruction; and
  - (d) printing indicia corresponding to the transaction data in the memory with a printer in the machine responsive to the print instruction included in the first document.

2. The method according to claim 1 wherein the first markup language document includes instructions therein corresponding to a format, and wherein in step (d) the indicia is printed in accordance with the format.

3. The method according to claim 1 and further comprising the step of:

inputting customer identifying information to the machine, wherein data corresponding to the customer identifying information is included in the transaction data stored in the storing step.

4. The method according to claim 3 wherein the inputting step includes inputting a card into a card reader on the machine, wherein the customer identifying information corresponds to indicia read by the card reader from the card.

5. The method according to claim 1 wherein the transaction conducted in step (a) includes the dispense of at least one sheet from a sheet dispenser in the machine.

6. An automated banking machine comprising:

a computer in operative connection with a memory;

a printer in operative connection with the computer;

a cash dispenser in operative connection with the computer; and

software executable in the computer, wherein the software is operative:

to cause the computer to store transaction data corresponding to a transaction involving the cash dispenser in the memory;

to cause the computer to access at least one markup language document, wherein the at least one markup language document includes at least one print instruction; and

to cause the printer to print at least one item which includes indicia representative of at least one portion of the transaction data responsive to the print instruction and the transaction data stored in the memory.

7. An automated banking machine according to claim 6, wherein the at least one markup language document does not include the at least one portion of the transaction data.

8. The method according to claim 1 and further comprising the steps of:

e) providing a plurality of markup language documents accessible through a server, said documents including the first document, and a second document wherein the second document includes at least one second print instruction;

f) accessing the second markup language document with the browser; *and*

g) printing indicia corresponding to the transaction data in memory with the printer in the machine responsive to the second print instruction included in the second document.

9. The method according to claim 8 wherein the first document includes indicia in a first language and the second document includes indicia in a second language, and wherein in step (d) a printed item including transaction indicia is produced in a first language and in step (g) a printed item is produced including transaction indicia in a second language.

10. The method according to claim 1 wherein the first document includes indicia representative of machine readable indicia, wherein in step (d) a printed item is produced including machine readable indicia.

11. The method according to claim 1 wherein in step (d) the printer is operative to print a transaction receipt.

12. The method according to claim 1 wherein in step (d) the printer is operative to print a check.

13. The method according to claim 1 wherein in step (d) the printer is operative to print a wagering slip.

14. An automated banking machine including:

a plurality of transaction function devices, the transaction function devices including a printer and an input device;

a computer in operative connection with the transaction function devices and a memory, wherein the computer includes software executable therein, wherein the software includes a browser;

wherein the software is operative to cause the computer to store in the memory transaction data representative of at least one input to an input device, and wherein the software is operative to cause the browser to access a markup language document including at least one print instruction and to operate the printer to print an item responsive to the print instruction and the transaction data.

15. An automated banking machine including:

a plurality of transaction function devices, the transaction function devices including a printer and an input device;

a computer in operative connection with the transaction function devices and a memory, wherein the computer includes software executable therein, wherein the software includes a browser;

wherein the software is operative to cause the computer to store in the memory transaction data representative of at least one input to the input device, wherein the software is operative to cause the browser to access a plurality of markup language documents through a server, the plurality of markup language documents including a first document and a second document, wherein the first document includes at least one first print instruction and the second document includes at least one second print instruction, and wherein the software is operative to cause the printer to print a first item responsive to the first print instruction included in the first document and at least a portion of the transaction data, and wherein the software is operative to cause the printer to print a second item responsive to the second print instruction included in the second document and at least a portion of the transaction data.

16. The machine according to claim 15, wherein the first document includes indicia in a first language and the second document includes indicia in a second language, and wherein the first

printed item includes indicia corresponding to at least a portion of the transaction data in the first language and the second printed item includes indicia corresponding to at least a portion of the transaction data in a second language.

17. An automated banking machine including:

a plurality of transaction function devices, the transaction function devices including a printer and an input device;

a computer in operative connection with the transaction function devices and a memory, wherein the computer includes software executable therein, wherein the software includes a browser;

wherein the software is operative to cause the computer to store in the memory transaction data representative of at least one input to the input device, and wherein the software is operative to cause the browser to access at least one markup language document including at least one print instruction and to operate the printer to print a check responsive to the print instruction and at least a portion of the transaction data.

18. An automated banking machine including:

a plurality of transaction function devices, the transaction function devices including a printer and an input device;

a computer in operative connection with the transaction function devices and a memory, wherein the computer includes software executable therein, wherein the software includes a browser;

wherein the software is operative to cause the computer to store in the memory transaction data representative of at least one input to the input device, and wherein the software is operative to cause the browser to access at least one markup language document including at least one print instruction and to operate the printer to print a wagering slip responsive to the print instruction and at least a portion of the transaction data.

19. The machine according to claim 14, wherein the at least one markup language document includes instructions therein corresponding to a format, and wherein the item includes indicia corresponding to at least a portion of the transaction data, which indicia is printed on the item in accordance with the format.

20. The machine according to claim 14, wherein the transaction function devices include a cash dispenser, wherein the software is further operative to cause the cash dispenser to dispense an amount of cash.

21. Computer readable media bearing instructions which are operative to cause at least one computer in an automated banking machine to cause the automated banking machine to carry out a method comprising:

- (a) conducting at least one transaction with the machine;
- (b) storing transaction data corresponding to the transaction in a memory in operative connection with a computer, wherein the computer is operatively connected with the machine;
- (c) accessing a first markup language document with a browser operating in the computer, wherein the first markup language document includes at least one print instruction; and
- (d) printing indicia corresponding to the transaction data in the memory with a printer in the machine responsive to the print instruction included in the first document.

22. The computer readable media according to claim 21, wherein the instructions are further operative to cause the at least one computer in the automated banking machine to cause the automated banking machine to carry out a method further comprising:

- e) providing a plurality of markup language documents accessible through a server, the documents including the first document, and a second document wherein the second document includes at least one second print instruction;
- f) accessing the second markup language document with the browser;
- g) printing indicia corresponding to the transaction data in memory with the printer in the machine responsive to the second print instruction included in the second document.

23. The computer readable media according to claim 21, wherein in step (d) the printer is operative to print a check.

24. The computer readable media according to claim 21, wherein in step (d) the printer is operative to print a wagering slip.

25. A method of printing a document with an automated banking machine, comprising:

- (a) conducting at least one transaction with the machine involving the dispense of cash with a cash dispenser operatively connected with the machine;

- (b) storing transaction data corresponding to the transaction in a memory in operative connection with a computer, wherein the computer is operatively connected with the machine;
- (c) accessing at least one markup language document, wherein the at least one markup language document includes at least one print instruction; and
- (d) printing an item with indicia corresponding to at least one portion of the transaction data in the memory with a printer in the machine responsive to the print instruction included in the at least one markup language document and the transaction data stored in the memory.

26. The method according to claim 25, wherein in step (c) the at least one markup language document does not include the at least one portion of the transaction data.